

REMARKS

Favorable reconsideration and allowance of the claims of the present, as amended herein, application are respectfully requested.

In the Official Action, Claims 1-4 stand rejected under 35 USC §102(b) as allegedly anticipated by US Patent No. 5,834,504 to Tang et al. ("the '504 patent"). Specifically, the Official Action alleges that the '504 patent teaches a compound of 3-[(2,4-Dimethylpyrrol-5-yl)methylene]-2-indolinone which reads on the present claims.

In response, applicants have amended Claims in a manner as shown in the above. Specifically, applicants have amended Claim 1 by revising the definition of m from "m is 0 or integer from 1 to 4" to "m is an integer from 1 to 4". Therefore, the cited compound does not fall within the scope of the present claims.

In view of the above-described amendment, applicants respectfully submit that the present application is not anticipated by the '504 patent because the cited reference does not teach, disclose or suggest the presently claimed compounds and process of making the same compounds. No new matter has been added by the foregoing amendment.

In view of the above remarks, applicants submit that the instant rejection has been obviated. Reconsideration and withdrawal of the instant rejection is respectfully requested.

Furthermore, Claims 1-5 and 7 stand rejected under 35 U.S.C. §103(a) as allegedly unpatentable over the '504 patent in view of Plieninger et al., *Liebigs Ann. Chem.*, 1972, 195-201 ("Plieninger et al.").

In response, applicants respectfully submit that the remarks concerning the 102(b) rejection against Claims 1-4 apply equally well in the instant rejection, and therefore are incorporated herein by reference. Since the primary reference, the '504 patent fails to teach,

disclose or suggest the present application for the same reasons as discussed above, it follows that the basis of the *prima facie* obviousness no longer exists. As such, applicants respectfully submit that the instant rejection has been obviated. Reconsideration and withdrawal of the instant rejection is respectfully requested.

In the Official Action, Claim 6 stands rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Plieninger et al. Specifically, the Official Action alleges that Plieninger et al. does not teach a methyl group in the 5-position of the pyrrolidine, but a person skilled in the art would be motivated to modify the structure and arrive to the present invention.

In response, applicants submit that compounds recited in Claim 6 are not disclosed or suggested by Plieninger et al. Specifically, a person skilled in the art would not be motivated to modify the hydrogen group in the 5-position of the pyrrolidine to a methyl group, which is in accordance with the present invention. More specifically, and contrary to what the Official Action indicates, i.e. that the difference between hydrogen and methyl is insignificant, applicants submit that there is substantial distinction between these two groups in terms of size, polarity, and solubility. Therefore, applicants submit that there is no disclosure or suggestion in Plieninger et al. which would motivate a person skilled in the art to make the modification as alleged by the Official Action, and meanwhile have a reasonable expectation of the success.

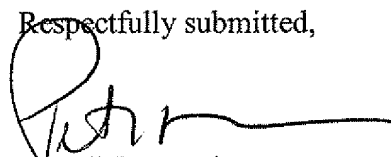
It is to be noted that the Supreme Court's decision in KSR International Co., v. Teleflex, Inc., 127 S.Ct 1727 (2007), acknowledges the importance of identifying "a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in a way the claimed new invention does." KSR at 1741. Furthermore, in a post-KSR Federal Circuits decision, Takeda Chemical Industries, Ltd. v. Alphapharma Pty., Ltd., 492 F.3d 1350, Judge Lourie stated: "[t]hus, in cases involving new chemical compounds, it remains necessary

to identify some reason that would have led a chemist to modify a known compound in a particular manner to establish prima facie obviousness of a new claimed compound.” Takeda at 1357.

In view of the above remarks, applicants respectfully submit that the instant §103 rejection over Plieninger et al. has been obviated, and withdrawal thereof is respectfully requested.

Thus, in view of the foregoing amendments and remarks, it is firmly believed that the present case is in condition for allowance, which action is earnestly solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "P. Bernstein", written over a horizontal line.

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